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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,125	10/31/2003	Julie A. Gannon	03-364	4999
719 Caterpillar Inc. Intellectual Property Dept. AH 9510 100 N.E. Adams Street PEORIA, IL 61629-9510	7590 06/19/2009			
EXAMINER				
CERVETTI, DAVID GARCIA				
ART UNIT		PAPER NUMBER		
2436				
MAIL DATE		DELIVERY MODE		
06/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,125

Applicant(s)

GANNON ET AL.

Examiner

David García Cervetti

Art Unit

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-51 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments filed October 14, 2008 and March 5, 2009, have been fully considered.
2. Claims 1-51 are pending and have been examined.

Response to Amendment

3. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claim(s) 1-50 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, *a statutory "process" under 35 U.S.C. 101 must (1) be tied to a particular machine, or (2) transform underlying subject matter* (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The method including steps of ... is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is

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any transformation apparent. The method claims are not tied to a particular machine nor do they transform underlying subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-11, 14-17, 24, 39-42, and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (US 2007/0050301).**

Regarding claims 1, 24, and 51, Johnson teaches

a method of enabling a software option located on a remote machine, comprising
(abstract):

receiving a request, at a remote facility configured to authorize said request, to enable a software option (par.34-37, customer requests license from representative);

authorizing said request (par.34-37, representative approves license);

delivering a first enabling signal, from said remote facility, to an intermediary in response to the authorization (par.34-37, customer access license server); and

delivering a second enabling signal, from said intermediary, to a remote machine in response to said first enabling signal (par.34-37, customer uses license from server).

Regarding claim 39, Johnson teaches

a method of enabling a software option located on a remote machine, comprising (abstract):

receiving a request to enable a software option (par.34-37, customer requests license from representative);

enabling said software option during a trial period (par.30, temporary license);

notifying a user with respect to an expiration of said trial period (par.30, notification to customer);

receiving a request to enable said software option in response to said notification (par.30, offer sent to server);

authorizing said request (par.34-37, representative approves license); and

delivering an enabling signal to a remote machine (par.34-37, customer uses license from server).

Regarding claim 2, Johnson teaches wherein said intermediary authenticates said enabling signal (par.34-37).

Regarding claim 3, Johnson teaches wherein delivering said second enabling signal further comprises delivering said second enabling signal in response to said authenticating said first enabling signal (par.34-39).

Regarding claim 4, Johnson teaches establishing a machine specific configuration; and generating said software option request in response to said machine specific configuration (par.42-46).

Regarding claim 5, Johnson teaches delivering said second enabling signal to a controller located on said machine (par.42-46).

Regarding claim 6, Johnson teaches wherein said request is generated by a software program needing said software option (par.58-65).

Regarding claim 7, Johnson teaches wherein delivering said second signal further comprises delivering said second signal to a plurality of controllers located on said remote machine (par.58-65).

Regarding claim 8, Johnson teaches initiating a billing process in response to said authorization (par.34-37, 58-65).

Regarding claim 9, Johnson teaches determining if one of an entitlement and a credit is available in response to said billing process initiation (par.19-37).

Regarding claim 10, Johnson teaches wherein authorizing said enablement further comprises: authorizing said enablement in response to an entitlement associated with said software option (par.19-37).

Regarding claim 11, Johnson teaches wherein said intermediary is a gateway network (fig.1).

Regarding claim 14, Johnson teaches wherein authorizing said enablement further includes authorizing said enablement for a time period (par.19-37).

Regarding claim 15, Johnson teaches wherein receiving said request further comprises receiving said request from a dealer associated with said machine (par.19-37).

Regarding claim 16, Johnson teaches wherein authorizing said enablement further includes authorizing said enablement by a manufacturer associated with said machine (par.19-37).

Regarding claim 17, Johnson teaches generating a request to enable said software option by a first machine (par.19-37).

Regarding claim 40, Johnson teaches generating a disable signal in response to said trial period expiration (par.22-31, time bomb).

Regarding claim 41, Johnson teaches disabling said software option in response to said disable signal and a machine status (par.22-31, machine is on).

Regarding claim 42, Johnson teaches wherein said machine status includes one of power up and off (par.22-31, machine is on).

9. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Gaetano, JR (US 2005/0038751).

Regarding claim 27, Gaetano teaches
a method of enabling a software option located on a replacement processor of a remote machine, comprising:

identifying a failed processor associated with a replacement processor;
receiving a request to enable a software option;
authorizing said request in response to said identified failed processor; and
delivering an enabling signal to said replacement processor in response to said authorization (par.63-67, backup CPU associated with master CPU, shares special license, upon failure takes over, authorized based on tag).

10. Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Asayama (US 2003/0046189).

Regarding claim 43, Asayama teaches

a method of disabling a software option located on a remote machine, comprising (abstract):

receiving a request to disable said a software option; disabling said software option (par.25-27, disabling features); and

receiving a disabled characteristic associated with said software option (fig.4, database with disabled/enabled features listed).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, and further in view of Gaetano.

Regarding claims 12-13, Johnson does not expressly disclose, however Gaetano teaches generating said request in response to a controller failing / wherein said request includes a failed controller characteristic and a replacement controller characteristic (par.63-67, backup CPU associated with master CPU, shares special license, upon failure takes over, authorized based on tag). Therefore, it would have been obvious to someone of ordinary skill in the art at the time the invention was made to provide failover capabilities as taught by Gaetano on the system of Johnson to provide for faster failover capabilities.

13. Claims 30-38 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asayama, and further in view of Beetcher et al. (US5,933,497, hereinafter Beetcher).

Regarding claims 30 and 50, Asayama teaches

a method of disabling a software option located on a remote machine, comprising (abstract):

receiving a request to disable said a software option; disabling said software option (par.25-27, disabling features); and

receiving a disabled characteristic associated with said software option (fig.4, database with disabled/enabled features listed).

Asayama does not expressly disclose an entitlement, however, Examiner takes Official Notice that the use of crediting on disabling features was conventional and well known (analogous to returning items at a conventional store) and Beetcher teaches such features (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to credit a customer upon disabling previously enabled features of a product since Examiner takes Official Notice that it was conventional and well known and to combine the teachings of Beetcher with the system of Asayama to provide means of enabling/disabling software features (Beetcher, col.1-2).

Regarding claim 31, the combination of Asayama and Beetcher teaches wherein said entitlement is associated with said disabled software option (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 32, the combination of Asayama and Beetcher teaches authenticating said disabled characteristic (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 33, the combination of Asayama and Beetcher teaches wherein the establishing an entitlement further comprises establishing said entitlement in response to said authentication (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 34, the combination of Asayama and Beetcher teaches receiving a request to enable a software option on a second machine; and authorizing said request in response to said entitlement (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 35, the combination of Asayama and Beetcher teaches authenticating said request in response to a controller characteristic and a software option status; and generating a disable signal in response to said authentication (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 36, the combination of Asayama and Beetcher teaches wherein the disabling said software option further comprises disabling said software option in response to said disable signal and a machine status (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 37, the combination of Asayama and Beetcher teaches wherein said machine status includes one of power up and power down (Asayama, col.6, lines 40-67, col.7, lines 15-67).

Regarding claim 38, the combination of Asayama and Beetcher teaches wherein said machine status includes an implement status (Asayama, col.6, lines 40-67, col.7, lines 15-67).

14. Claim 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson.

Regarding claim 44, Johnson teaches a method of enabling a software option located on a remote machine, comprising:

- receiving a request to enable said a software option;
- authorizing said request in response to a dealer characteristic and a machine characteristic; and
- delivering an enabling signal to said a remote machine (pars.30-37, see claim 39 above).

Johnson does not expressly disclose the **labels** used in the claim, however, teaches the overall architecture to receive and authorize a request, and enable an option. It is irrelevant who uses the different machines/architectures. Examiner takes Official Notice that a manufacturer and dealer could make use of Johnson's invention without changes, thus becoming a manufacture/dealer/customer ternary.

Regarding claim 45, Johnson teaches wherein the delivering an enabling signal to said remote customer machine further comprises: delivering an enabling signal to said dealer in response to said authorization; and delivering said enabling signal to said remote customer machine in response to said dealer receipt (pars.30-37).

Allowable Subject Matter

15. Claim 49 would be allowable.
16. Claims 18-23, 25-26, 28-29, 46-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David García Cervetti whose telephone number is (571)272-5861. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.
18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on (571)272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David García Cervetti/
Primary Examiner, Art Unit 2436